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JUN 29 2010

UNITED STATES DEPARTMENT OF COMMERCE
UNITED STATES PATENT AND TRADEMARK OFFICE**IN ACCORDANCE WITH THE PATENT COOPERATION TREATY**

Invention: **IMPROVEMENTS IN TRUNCHEONS
PROTECTIVE BATONS AND CANES**
US National Appln. Serial No.: **10/578,468**
US National Filing Date: **05/05/2006**
International Application No.: **PCT/CA2004/001933**
International Filing Date: **08/11/2004**
Priority Date: **06/11/2003**
Priority Appln. No.: **CANADA 2,453,171**
Applicant: **SITEMAN, WALTER DENIS**
Examiner: **Robert K. Nichols II**
Group Art Unit **1645**
Our File: **SITG008**
FAX NO. 571-273-8300

URGENT**Director of the USPTO**

June 29, 2010

U.S. Patent and Trademark Office
Mail Stop PCT
Post Office Box 1450
Alexandria, VA, 22313-1450
U. S. A.

Attention: **KEVIN P. SHAVER** Supervisory Patent Examiner Art Unit 3754

Dear Sir:

The Official Action dated **6/15/2010** entitled **Notice of Abandonment** has been observed from the USPTO website. Following that observation a telephone contact to Mr. Shaver was undertaken but not completed, but with Applicant's agent recording a message that the notation in the Notice under paragraph 1 (d) to the effect that Applicant had failed to timely file a proper reply to the Office letter mailed on 08 December 2009 and that **no reply had been received** was clearly

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erroneous.

Applicant by facsimile on **March 8, 2010** did deliver a **full answer** to the **"final action"** dated **08/12/09** which was recorded as received by the USPTO on that day and appears in the website file of this application detailing the status of same.

Indeed Applicant contended in that response that the provision determining when a "final action" was appropriate, MPEP S. 706 07(a), **failed to support the Examiner's assertion to that end and should be withdrawn.**

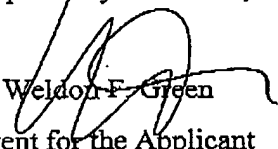
In substance it was contended that the latest combinations of the **old** prior art with a **new** citation could not support a "final action" pronouncement; nor could the rejection under USC 103 (a) be sustained on a careful appraisal of the structures identified by the Examiner; that modifications urged by him according to his analysis could not be justified. That the teachings of the instant application, namely hindsight evaluation, had led him into error.

It is essential to assert that a full answer was timely delivered on March 8, 2010. Indeed not only our records but record maintained in the USPTO website for this application confirm that status.

Will the supervisory Examiner Kevin P. Shaver take this matter up forthwith and deliver to Applicant's agent a **retraction of the Notice of Abandonment** and proceed to consider Applicant's response of March 8, 2010.

Out of an abundance of caution a true copy of the March 8, 2010 response is attached.

All of which is respectfully submitted,


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Director of the USPTO**March 8, 2010**

U.S. Patent and Trademark Office
Mail Stop PCT
Post Office Box 1450
Alexandria, VA, 22313-1450
U. S. A.

Dear Sir:

We are pleased, on behalf of the Applicant, to acknowledge delivery of the Official Action dated **December 8, 2009** concerning this application. A shortened time for reply has been set to expire **3 months** or thirty (30) days whichever is longer. Accordingly the due date for response is **March 8, 2010**.

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1.0 CLAIMS OF RECORD

The claims of record are maintained and included in this response and appear on pages 14, 15 and 16 of this submission.

Applicant submits that as amended and characterized in his submission of August 8, 2009 those claims of record both clearly and patentably distinguish Applicant's invention from the cited prior art, either taken singly or in combination, defining novel and unobvious subject matter thereover.

2.0 FINAL ACTION declared: Official Action p. 8

Applicant asserts, with respect, that the declaration by the Examiner that a "final action" is warranted is **not** supported by the record nor can it be justified under the provisions/language of MPEP S.706.07(a). That ruling should be withdrawn or set aside..

Under "Conclusion" page 8 of the Official Action, the Examiner contends that Applicant's amendments to the claims **necessitated the new grounds of rejection** presented in the instant Office Action under MPEP S 706.07(a). That assessment cannot stand.

This Official Action of **December 8, 2009** responds to Applicants submission filed **August 8, 2009**. In that submission the claims then of record were **amended** to enhance/emphasize the inherent **axially extended** gripped relationship of matching and engaged walls of cavity to reservoir of the invention so as to make clear that the **two component** arrangement of Applicant's instrument of defence embodying the invention came nowhere near the structure of the **single** piece of prior art, cited and applied by the Examiner in the first action on the merits , namely **Denison USP 5,709,635** under **35 USC 102(b)**.

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Denison has been withdrawn as a barring reference.

The Examiner had contended that Denison **anticipated** the invention as **claimed**; and had rejected **all** of the claims of record under 35 USC 102(b)

In the response/submission of **August 8, 2009**, directed to setting aside **Denison**, the alleged anticipation, Applicant pointed out the **structural differences** that characterized the instant invention, as then claimed, and that were absent in Denison (see page 7 of that August 8, 2009 response); that it was **conclusive** that Denison could not serve to **defeat** the **two component simplification** for a commercial **instrument of defence** achieved by Applicant through the capturing engagement, the **anchoring** of the two components, the handle portion and the fluid reservoir of the spray dispensing unit against separation so conformed as to the shaping/configuration (tolerances) of the axially extending mated boundary surfaces as to exert/generate sufficient gripping engagement therebetween **when aligned and mated through the application of press fit forces**.

That is a novel concept.

It turned out that such **two component** concept, the configuring/shaping of the two components so as to exert frictional gripping engagement substantially throughout the axially extent of the mated boundary surfaces under a sufficient press fit not only worked very well it made the market place . No cited prior reference nor any of the suggested combinations of same now urged by the Examiner teaches such an arrangement.

As will appear all uncovered US patents applied in this proceeding to the claims require at least **three (3) or more** and in a different setting as will be shown.

As for the appeal of the **simplicity** established by Applicant's arrangement as against the

apparent complexities of all the cited prior art, **all of the latter have expired** through failure to maintain

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same.

An inference therefore can be drawn that the **complexities** of all such proposals appearing in the cited, expired and/or abandoned prior art, i.e. their need for many special parts, including threaded elements, the increased costs of production and assembly of same and the settings probably discouraged if not prevented profitable commercial exploitation.

In fact, in Applicant's response filed August 8, 2009 the **complexity of Denison** as against **simplicity** of the instant invention was stressed.

A simplicity factor, only two components as against several, is a very important contribution not only to this field as outlined in the disclosure but to any other field of endeavour, witness that the Denison US patent had **expired** before its time, whereas, as earlier demonstrated, Applicant's two component invention was being featured in competitive advertising on the internet..

Now it has been confirmed that all of the US cited prior art featuring complexity if nothing else have expired from which the same inference, no interest, too costly etc., as in the case of Denison can be drawn.

Now comes the Examiner in this second action **on the merits** not only **rejecting** all the claims amended only to **enhance/emphasize** that **special gripping relationship** between reservoir and cavity walls (**not** to be found in Denison) on allegedly **new grounds**, invoking instead **35 USC 103 (a)** and citing in support **new combinations of** references of record with **ALVEY USP 6,736,523** cited for the **first time** together with the other patents as a **major bar to acceptance of the claims of record** ALVEY interpreted as having, according to the Examiner's observation, **controlling** significance in that it presents essentially a **two part system in a setting** as claimed by Applicant and therefore

obvious to modify the principal references.

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Applicant respectfully contends that the amendments undertaken to the claims in the face of Denison, to emphasize the relationship of components should have been and should now be characterized as **inherent** or **self evident** from the **originally filed claim language**, if claims are to be construed/ interpreted, as dictated by the controlling US jurisprudence, that is by considering the **entire** specification.

Paragraphs 0044 and 0045 of Applicant's published application under US 2007/0045346 of March 1, 2007 read:

" (0044) The contour or shape 22A of the recess or cavity wall of handle 18A mirrors the cylindrical shape of the reservoir 26A to a tolerance that establishes sufficient frictional gripping engagement of the respective surfaces when reservoir 26A is fully inserted into the recess or cavity to be accomplished by a press fit so that disengagement is **effectively controlled or prevented**.

(0045) The reservoir 26A is **secured** within the recess or cavity of handle 18A by applying directional thrust to those aligned components; and removal accomplished in reverse **after depletion** of the pressurized liquid deterrent/repellant with a strong pull in the opposite direction"

The cavity remains **open ended**, **axially of the spray head dispensing mechanism** and depending reservoir when joined together . A cap closure or its equivalent for same to "contain" the reservoir and associated dispensing mechanism is not only **absent**. It is superfluous in the arrangement described and claimed .

From that perspective the amended claim construction (adopted having regard to

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Applicant's entire specification, and after having had Denison cited as an anticipation of the invention as first claimed) has not only passed muster over Denison, but has contributed greater clarity to US the concept as claimed and so framed patentable over the newly applied references..

What has led to the new rejections under 35 USC 103 (a) is the **uncovering** and **citing** for the **first time** of a supposedly more significant reference, namely **ALVEY USP 6,736,523**, used by the Examiner to qualify earlier disclosed **but not earlier applied patents** to **Tuscher USP 5,941,629** in relation to claim 11, **Banks et. al. USP 5,529,215** in relation to claims 8, 10 and 11 and **Wolfram USP 5,405,134** in relation to claims 3, 6, 11, and 12 .

The Examiner in the second action on the merits has not only introduced a **new grounds of rejection 35 USC 103(a)** but in doing so introduced and applied a **new reference, ALVEY**, which he asserts can be plainly read by persons skilled in the art to modify the disclosures of the now named and applied principal references noted above with little or no difficulty and without the teachings of this application.

Applicant respectfully contends that such approach should be actually characterized as **hindsight evaluation**. Without the **teaching** of the instant application how would such persons go about it? It is the teaching, the simplification, **the two component concept** detailed by Applicant that led to the research and to the steps followed by the Examiner. .

MPEP Section 706.07 reads in part:

“ Under present practice, second or any subsequent actions on the merits shall be final **except** where the examiner introduces a **new ground of rejection**.....Furthermore, a second or any subsequent action on the merits in **any application** or patent undergoing reexamination proceedings will **not be made final** if it includes a rejection on **newly cited art**....”

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ALVEY is newly cited art. The combinations of the named and applied US patents with **ALVEY** taken by the Examiner all likewise qualify as newly cited art..

Applicant therefore asserts that the "FINAL ACTION" ruling made in this proceeding is unjustified. Clearly it goes against the language, qualifications and intent of MPEP Section 706.07 and therefore is unauthorized.

FURTHER REMARKS

Claims 3-12 as amended remain pending in this application. See the following separate pages

Claims 4, 5, 7 and 9 have been withdrawn from consideration on the merits.

Claims 3, 6, 8, and 10, 11 and 12 of record, respectively, have been rejected on the disclosures of the above newly cited and applied US patents, under the practice as interpreted by the Examiner. Those claims introduced to meet the challenge based upon Denison are again put forward without further amendment and asserted as clearly allowable over the latest challenges..

Turning first to the rejection of **Claim 11**, page 3, under 35USC 103(a) the Examiner has conceded that **Tuscher USP5941629**

"is silent to the teaching of presenting opposed axially extending boundary surfaces of mating configuration substantially throughout their extent and of a tolerance such that in mated alignment under a press fit such boundary surfaces exert sufficient frictional gripping engagement therebetween."

The Examiner then, in contending **Tuscher** could be modified to meet the claim 11 language turns to newly cited **ALVEY USP 6,736,523** as a source of teaching the following to an ordinary person skilled in the art, pointing to **figures 2 and 4** thereof together with the description at **column 3 lines 40-**

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43 the Examiner contending at page 3 of the Official Action that in ALVEY the :

"handle portion has a free end and a cavity 56 with a mouth opening outwardly from the free end thereof for the reception of a spray dispensing unit including a spray head mechanism with a depending fluid reservoir 40"

In ALVEY's concept of his embodiment there is no free end. The free end must be closed with cap 60

Further the Examiner contends that ALVEY discloses:

"the cavity 56 and reservoir 40 presenting opposed axially extending boundary surfaces of mating configuration, substantially throughout their extent, and of a tolerance such that in mated alignment under a press fit such boundary surfaces exert sufficient frictional gripping engagement therebetween to interlock the two members"

They do not interlock. The words used by ALVEY are "slidably lock about". Both terms are to be distinguished from "anchor"..

Figure 2 of ALVEY shows a spray dispensing device disposed within a cavity in inwardly spaced relation to the cavity wall. Spacer and locating elements 46 and 48 apparently are introduced to position the device. Moreover Figure 2 depicts a cap 18 threaded as at 19 to engage the internal threads 36 of casing 34 to close the mouth thereof.

Such proposal illustrated in Figure 2 and as described does not teach Applicant's unique approach to providing in principle simply a two component, uniquely configured, instrument of defence, nothing more.

Obviously such proposal of Figure 2 of ALVEY involves providing more than two parts.

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Several parts, at least five, must be formed or selected, parts that require special treatment, as in the assembly of same by attachment, by threaded engagement and possibly employ other instruments of assembly or jigs. Such an approach only emphasizes **complexity** and **costs** which discourage if not prohibit investment to commercialize same.

That might explain why the **ALVEY** patent expired on **05/18/2007**. See attached printout.

ALVEY, having regard to Figure 4, contrary to what the Examiner contends, fails to depict or describe any **"interlock"** as that term is used by the Examiner to qualify **ALVEY**. on pages 4, 5 and 7 of the Official Action; nor does it really equate to the **anchoring** of the structures as depicted and described by Applicant in this application.

There is no suggestion, let alone any reference or teaching in **ALVEY** that in his arrangement his two components, container casing 34 and personal defence spray cartridge 40, without more, work in their association! Nor are they alone **anchored** together against separation or displacement. Rather **ALVEY** in his reduction to practice of the embodiment of Figure 4 requires a **third** component, the cap 60, depicted in Figures 6A, 6B and , 7A to 7E inclusive , to establish proper **containment and orientation**.

With the required cap 60 in place there is no possibility of **ALVEY's** spray head mechanism 40 to be **sufficiently exposed at an axially opening "cavity mouth"** for the ready actuation of same on demand. The "mouth" identified by the Examiner is **necessarily closed** for successful cooperation.

And so the solely **two component** arrangement depicted, described in clearly understood language in relation to Applicant's models embodying his invention and now clearly defined in the claims now of record is clearly **absent** in **ALVEY**.

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More particularly the **words** used by ALVEY in column 3, lines 40- 43 plainly **differ** from the language choice iterated by the Examiner in his characterization of the ALVEY proposal, especially that of Figure 4.

The Examiner in every paragraph of the Official Action detailing the arrangement of cavity 56 and reservoir 40 of Figure 4 of ALVEY whether in relation to the rejection of Claim 11, Claims 8, 10 and 11 and Claim 11 combined with Tuscher, Banks et. al. or Wolfram respectively always uses the expression **"to interlock"** in relation to ALVEY's **"two members"**.

Again ALVEY in the lines cited by the Examiner describes Figures 4 -7E in the following terms:

"Other forms of the invention as shown in FIGS. 4-7E show a container casing 34 having a formed or milled-out hollow interior surface 56 that is formed to adapt and **slidably lock about** the personal defence spray cartridge."

The expression **"slidably lock about"** does not convey the connotation of **interlock** i.e. secured against displacement.. Moreover the expression used in Applicant's claim 11 and 12 is **"anchor same against separation"** a fixation of the components which does not permit any sliding.

Nor is there **any** portrayal or description of structure in relation to Figure 4 that could be taken to **advocate** that the axially extending boundary surfaces of the two ALVEY components are of

"mating configuration substantially throughout their extent and of a **tolerance** such that in mated alignment **under a press fit** such boundary surfaces exert sufficient axially extending frictional gripping engagement therebetween **to anchor same against separation** when transported or in combat."

as called for in Claims 11 and 12.

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The components **slide**.

To **describe** “slidably lock about” as an “interlock” is to ignore the “slidable” factor of ALVEY.

Nor does either expression signify “**anchor**” in the setting of claims 11 and 12 of Applicant’s application.

It however becomes **very clear** having regard to ALVEY’s proposal from reading further down column 3 to lines 44 to 53, that it is the internally threaded **end cap 60** (in interfitting with the external screw threads of auxiliary container 30, shown in Figures 7A to 7E) a **third** component, that presents structure that **interlocks** with **spray canister 40** and **prevents** “the canisters rotation and axial movement within auxiliary container 30.” Column 3 lines 49 to 53.

So Applicant’s two component concept cannot be found in ALVEY.

Further the inferences and conclusions concerning the so called gripping relationship between the two members of ALVEY as detailed by the Examiner in his rejection of the claims of record cannot stand..

It can be concluded from the foregoing observations that Alvey **always** requires at least **three (3) components** in providing an instrument of defence, **not just two**.

Further with the **cap 60** closing the end of the auxiliary container 30 there **cannot be any** “mouth” axially oriented at which, in the language of claims 11 and 12, “ the spray head mechanism is sufficiently exposed for ready actuation of same on demand”.

Not only does the Examiner concede that Tuscher is **silent** to Applicant’s teaching, see page 3 of

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the Official Action, but Banks et. al. likewise is **silent** see page 4, last line of the Official Action.

As for Wolfram, **bearing screws 910** are used to hold the two parts against separation not only requiring at least three or more components to achieve unity but also involves performing additional steps for assembling same and incurring the attendant costs. The Examiner would also have to introduce ALVEY's **cap 60** into Wolfram's arrangement

Alvey dictates to a person skilled in the art that at least **three (3)** components are required in stabilizing or fixing the components in operative relationship.

Accepting that analysis, that a cap is **necessary** in ALVEY's proposal, it is difficult if not impossible to predict that any of the ALVEY proposed arrangements could be used to modify any of Tuscher, Banks et al or Wolfram let alone to equate to Applicant's concept..

Hence it follows, contrary to all of the views expressed by the Examiner, that the claims of record are neither anticipated nor obvious and since all of them both clearly and patentably distinguish applicants invention from all the cited and applied prior art should now be allowed.

It is also of merit that the claims first asserted in this application based upon the parent cited PCT case were found in examination before the PCT Office and before the Canadian Patent Office of the CIPO to cover both novel and patentable subject matter. See attached CIPO printout of the particulars of the Canadian Patent No 2453171 issued January 29, 2008 to Applicant . It is the Canadian application upon which CP No. 2453171 issued that establishes the claim to priority for the instant application.

The matter of recognizing and rewarding **simplification over complexity** is usually contentious and deserving of careful appraisal. But where a **new** path is found and is revealed and sufficiently and patentably defined over what has gone before, whether small or great, and is shown to have yielded

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results leading to successful commercial exploitation in a crowded field (in which patents uncovered and applied to show the state of the art have all expired or have been abandoned) the inference has to be drawn that this is a new approach and not only really works, but no one has been shown to have done it before, and therefore unobvious and should be protected.

The US Code as well as the Canadian Patent Act are intended to persuade inventors to reveal their contributions for which they will be rewarded if novel and unobvious. In this instance the proposal is novel, that only two components, not three or more, are needed to achieve the result desired. Novel, demonstrably workable and advanced economically, this invention as defined in the claims of record should be allowed.

Accordingly the claims of record appearing in the following pages 11, 12 and 13 are resubmitted for reconsideration and allowance.

ABSTRACT

Finally, as indicated in an earlier response, the narrative of the ABSTRACT will be amended to conform to the format spelled out in the Official Action on page 2 **upon allowance of the claims.**

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CLAIMS OF RECORD

Claim 1 (cancelled)

Claim 2 (cancelled)

Claim 3 (currently amended)

An instrument according to claims [[1 or 2]] 11 or 12 wherein said cavity mouth of said handle portion opens outwardly in spaced apart relation to one end of said shaft portion.

Claim 4 (currently amended and withdrawn from consideration)

An instrument according to claims [[1 or 2]] 11 or 12 wherein said handle portion is disposed at an obtuse angle to said shaft portion.

Claim 5 (currently amended and withdrawn from consideration)

An instrument according to claims [[1 or 2]] 11 or 12 wherein said handle portion is disposed at substantially right angles to said shaft portion and towards one end

Claim 6 (currently amended)

An instrument according to claims [[1 to 5 inclusive]] 11 or 12 wherein the girth of said handle portion exceeds that of said shaft portion.

Claim 7 (currently amended and withdrawn from consideration)

An instrument according to claims [[1 or 2]] 11 or 12 wherein said handle portion and said shaft portion have the configuration of a truncheon

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Claim 8 (currently amended)

An instrument according to claims [[1 or 2]] **11 or 12** wherein said handle portion and said shaft portion have the configuration of a baton.

Claim 9 (currently amended and withdrawn from consideration)

An instrument according to claims [[1 or 2]] **11 or 12** wherein said handle portion and said shaft portion have the configuration of a walking cane.

Claim 10 (currently amended)

An instrument according to claims [[1 to 9 inclusive]] **11 or 12** wherein said shaft portion is suitably apertured for reception of a tie or thong for supporting same for carriage or storage.

Claim 11 (new)

In an instrument of defence wherein a handle portion for an integral shaft portion has a free end and a cavity with a mouth opening outwardly from the free end thereof for the reception of a spray dispensing unit including a spray head mechanism with a depending fluid reservoir, the cavity and reservoir having an axis of alignment and presenting opposed axially extending boundary surfaces of mating configuration substantially throughout their extent and of a tolerance such that in mated alignment under a press fit such boundary surfaces exert sufficient frictional gripping engagement therebetween to anchor same against separation when transported or in combat and with said spray head mechanism sufficiently exposed at the cavity mouth for the ready actuation of same on demand.

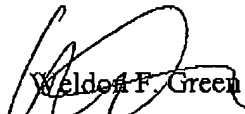
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Claim 12 (new).

In an instrument of defence, a handle portion for an integral shaft portion, the handle portion having a free end and a cavity with a mouth opening outwardly from the free end thereof for the reception of a spray dispensing unit including a spray head mechanism with a discharge orifice on one side, a displaceable spring-biased operating lever disposed toward the other side and with a depending fluid reservoir, the cavity and reservoir having an axis of alignment and presenting opposed axially extending boundary surfaces of mating configuration substantially throughout their extent and of a tolerance such that in mated alignment under a press fit such boundary surfaces exert sufficient axially extending frictional gripping engagement therebetween so as to anchor same against separation, and with the spray head mechanism disposed within the cavity mouth, the cavity mouth presenting a surrounding edge formation with a suitable contour exposing the discharge orifice on one side and with a slot formation exposing the displaceable spring-biased operating lever on the other side for displacement within the slot formation to dispense fluid spray.

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All of which is respectfully submitted,


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